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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,824	12/21/2000	Martin Quanz	114750.1600	6581

27160 7590 02/13/2003

PATENT ADMINSTRATOR
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EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/740,824

Applicant(s)

QUANZ ET AL.

Examiner

Francisco C Prats

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 January 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 9-23, 25 and 26.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Francisco C Prats
Primary Examiner
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ATTACHMENT TO ADVISORY ACTION

The after-final amendment filed January 30, 2003, has been received. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

The after-final amendment filed January 30, 2003, will not be entered because it raises new issues for search and consideration. Specifically, the claims now require a minimum conversion or yield for the claimed process. This minimum conversion or yield has not been searched or considered previously. Thus, the amendment clearly raises a new issue for search and consideration. Because the new claim language requires additional search and/or consideration, non-entry of the proposed amendment is clearly proper under 37 CFR § 1.116.

All of applicant's argument regarding the pending grounds of rejection has been fully considered but is not persuasive of error. With respect to the rejection under § 112, second paragraph, it is noted, as argued by applicant, that the proposed amendment would recite the purity in terms of specific activity, and that this activity can be compared to the specific activity of pure amylosucrase. However, despite applicant's assertion that the specific activity of pure amylosucrase is "known" (response of January 30, 2003, page 10), it is not clear

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what that specific activity actually is, or if there even is a single art-recognized specific activity for amylosucrase. The rejection must therefore be maintained.

With respect to the rejections under § 103(a), note specifically that the motivation for omitting the addition of buffer would have been the advantage of omitting a process step and the expense of a buffer, thereby making the process cheaper and easier. See pages 4 and 5 of the office action of July 30, 2002. Because the enzyme is active at neutral pH, and because the pH of water is neutral, the artisan of ordinary skill would have recognized that a buffer was not required, and would therefore have been motivated to have omitted the addition of the buffer to have made the process easier and cheaper.

It is noted, as argued by applicant, that buffers are often used to maintain pH during enzymatic procedures. However, applicant provides no evidence which would have suggested to the artisan of ordinary skill that any of the reactants or products in Kossman's process would have raised or lowered the pH outside of the enzyme's active pH range. Other than buffer, the reaction solutions used in Kossman and Remaud-Simeon contain only the polyglucose product, as well as the starting materials sucrose, enzyme, and in the case of Remaud-Simeon, glycogen primer. See Kossman, page 35, Example 4; see also Remaud-

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Simeon, page 315, section entitled "2.4. Reaction conditions."

None of these compounds would appear to contain sufficient dissociable protons to lower the pH significantly, nor do they contain proton-withdrawing moieties which would be expected to increase the pH significantly. In view of the fact that applicant has not to date presented any evidence which supports their assertions that an artisan of ordinary skill would have recognized the necessity of a buffer, the rejection must be maintained.

Similarly, applicant does not explain, using actual evidence, why the proposed new language regarding sucrose conversion demonstrates an unexpected result. That is, while applicant asserts that the sucrose conversion is unexpected, applicant does not explain why. Note specifically that argument by counsel cannot replace actual evidence. The rejections under § 103(a) must therefore be maintained.

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 703-308-3665. The examiner

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can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Francisco C Prats
Primary Examiner
Art Unit 1651

FCP
February 12, 2003